

GA 3635

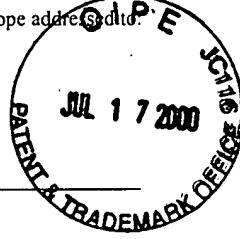
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Assistant Commissioner for Patents  
Washington, D.C. 20231

On 7-11-00

TOWNSEND and TOWNSEND and CREW LLP

By: Janet Byrne



PATENT  
Attorney Docket No.: 17342-000500US

#30  
88  
1/20/00  
TC 3600 MAIL ROOM

RECEIVED  
JUL 19 2000

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Barney D. Visser

Application No. 08/851,040

Filed: May 5, 1997

For: SYSTEMS AND METHODS FOR  
FACILITATING THE PRESENTATION  
OF INVENTORY ITEMS

Examiner: R. Chilcot

Art Unit: 3635

RESPONSE

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed April 11, 2000. In the Office Action, claims 21-26 and 28-36 were rejected under 35 USC 101 for being directed to non-statutory subject matter. Claims 1-4, 6-16, 18-26 and 28-36 were also rejected under 35 USC 103(b) as being anticipated by Searcy. As set forth hereinafter, both of these rejections are respectfully traversed.

### Claim Rejections – 35 U.S.C. 101

In rejecting claims 21-16 and 28-36, the Office Action indicates that such claims are directed to non-statutory subject matter, "and in particular these claims are directed to a method of doing business." Applicant respectfully disagrees. Claim 21-26 and 28-36 are method claims relating to presenting inventory items (see claim 21) and for enhancing the

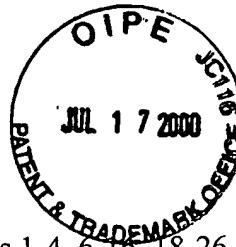
display space within a building (see claim 31). Both of these independent claims include the step of providing a structure or building that is of unique construction. Such a process is in no way related to "a method of doing business" as set forth in the Office Action.

As support for the §101 rejection of these claims, the Office Action cites MPEP sections 706.03(a), 2105, 2106-2106.02 and 2107-2107.02. However, these sections deal with the patentability of computer related claims. Since claims 21-26 and 28-36 are clearly not performed using a computer, these sections are completely irrelevant. For example, MPEP §2106V.B.2(b) requires that, "to be statutory, a claimed computer related process must either "(a) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan ... or (b) limited to a practical application within the technological arts." The process or method claims that are of issue are in no way related to either of these categories. Hence, reliance on this section of the MPEP to reject these claims is clearly unfounded.

The Office Action further recites that these claims are not patentable because they include "the human thought process" and thus fail to fall within the safe harbors of the methods of doing business. Applicant respectfully disagrees for two reasons. The safe harbors of business methods referred to in the Office Action relate to computer related activities and are thus clearly irrelevant. For example, the MPEP cites the two safe harbors as being an activity that requires physical acts to be performed outside the computer independent of and following the step to be performed by a programmed computer, and one that requires the measurements of physical objects or activities to be transformed outside of the computer into computer data. Second, the mere inclusion of a human performed step within a method or process claim clearly does not place the claim outside of statutory subject matter. Indeed, thousands of issued U.S. patents include method steps involving human actions and the human thought process. For example, nearly all surgical treatment claims involve the thought process of a surgeon. As another example, many chemical claims involve the manual process of mixing chemicals using the human thought process. Hence, the section 101 rejection of claims 21-26 and 28-36 is clearly without merit. It is therefore respectfully requested that the section 101 rejection of these claims be withdrawn.

Barney D. Visser  
Application No.: 08/851,040  
Page 3

PATENT



Claim Rejections – 35 USC 102

In the rejection of claims 1-4, 6-16, 18-26 and 28-36 in view of the Searcy patent, the Office Action merely recites language similar to that recited in previous Office Actions. Hence, these rejections are respectfully traversed for at least the same reasons previously set forth in Applicant's Appeal Brief Under 37 CFR §1.192 which is incorporated herein by reference. Moreover, the Office Action recites that the Examiner is taking judicial notice of many contemporary malls which have allegedly contain all the claim limitations of these claims. Applicant respectfully requests under MPEP 2144.03 that the Examiner cite a reference in support of this position.

Hence, for at least the reasons previously set forth by the Applicant, claims 1-4, 6-16, 18-26 and 26-36 are not anticipated by the Searcy reference. It is therefore respectfully requested that the section 102 rejection of these claims be withdrawn and the application be allowed to issue.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Darin J. Gibby  
Reg. No. 38,464

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: (303) 571-4000  
Fax: (303) 571-4321  
DJG:jlb  
DE 7019277 v1